

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK LEONARD BONKO

Appeal No. 2000-1221
Application No. 29/070,030

ON BRIEF

Before FRANKFORT, NASE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of the following design claim:

The ornamental Design for a TIRE as shown and described.

The prior art references of record relied upon by the examiner in rejecting the appealed claim are:

Bonko (Bonko '631)	Des. 367,631	Mar. 5, 1996
Bonko (Bonko '923)	Des. 377,923	Feb. 11, 1997

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The following rejection is before us for review.

The claim stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bonko '923 in view of Bonko '631.

Reference is made to the brief¹ (Paper No. 11) and the answer and supplemental answer (Paper Nos. 12 and 14) for the respective positions of the appellant and the examiner with regard to the merits of this rejection.

OPINION

Having carefully considered the respective positions advanced by the appellant in the brief and by the examiner in the answer, it is our conclusion that the references relied on by the examiner fail to establish a prima facie case of obviousness of the design claim on appeal within the meaning of 35 U.S.C. § 103. Our reasons for this conclusion follow.

The test for determining obviousness of a claimed design under 35 U.S.C. § 103 is whether the design would have been obvious to a designer of ordinary skill who designs articles of

¹ Any references to the "brief" in this decision are to the corrected brief filed October 5, 1998.

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the type involved. See In re Carter, 673 F.2d 1378, 1380, 213 USPQ 625, 626 (CCPA 1982) and In re Nalbandian, 661 F.2d 1214, 1216, 211 USPQ 782, 784 (CCPA 1981). The appellant's design lies in the realm of designers of tires.

In order to support a holding of obviousness under 35 U.S.C. § 103, there must be a reference, a something in existence, the design characteristics of which are basically the same as the claimed design. Such a reference is necessary whether the holding is based on the basic reference alone or on the basic reference in view of modifications suggested by secondary references. See In re Rosen, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982).

The appellant does not argue that the design characteristics of the tire of Bonko '923 are not basically the same as the claimed design on appeal. In this regard, we note that the tire of Bonko '923, like the claimed design, is a directional tire having a tread with a plurality of circumferentially spaced outer raised portions of the same shape and orientation as the outer raised portions of the claimed design on appeal and a plurality of circumferentially

spaced central raised portions. The central raised portions also appear to have the same shape as those of the appellant's claimed design. Thus, from our perspective, Bonko '923 satisfies the Rosen test, in that it is a something in existence, the design characteristics of which are basically the same as the claimed design.

There is, however, a material difference between the appellant's design and Bonko '923 which produces an overall appearance that would be recognized as different by an ordinary designer of tires. In particular, alternating ones of the central raised portions of Bonko '923 extend in opposite directions with respect to one another, while those of the appellant's design all extend in the same direction. Contrary to the examiner's contention that this difference is de minimis² (answer, page 4), it is our opinion that the aligned orientation of the central raised portions of the appellant's design does affect the appearance of the claimed design as a whole and the impression that the design would

² See Carter, 673 F.2d at 1380, 213 USPQ at 626.

make to the eye of a designer of tires of ordinary skill.³
The appellant's design gives an overall impression of aligned or parallel tread structures which is not present in the Bonko '923 design.

In addressing this difference, the examiner notes that Bonko '631 teaches the use on tires of central raised portions which all lean in the same direction. The examiner then concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to reorient the central raised portions in the Bonko '923 design to all lean in the same direction, as taught by the Bonko '631 design, resulting in a design having an appearance strikingly similar to that of the claimed design (answer, page 4).

We have carefully considered the combined teachings of Bonko '923 and Bonko '631, but we find therein no suggestion to combine the references as the examiner has proposed to arrive at the appellant's claimed design. As the court in In

³ Compare Ex parte Pappas, 23 USPQ2d 1636, 1638 (Bd. Pat. App. & Int. 1992) (Differences between the appellant's claimed design and the prior art designs were found de minimis, in that the net effect of such differences, if any, did not "affect the appearance of the claimed design as a whole and the impression that the design would make to the eye of a designer of ordinary skill.").

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re Harvey, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993) stated,

[i]n ornamental design cases, a proper obviousness rejection based on a combination of references requires that the visual ornamental features (design characteristics) of the claimed design appear in the prior art in a manner which suggests such features as used in the claimed design. If, however, the combined teachings suggest only components of a claimed design, but not its overall appearance, an obviousness rejection is inappropriate [citations omitted].

We note that, in contrast to the appellant's claimed design and the Bonko '923 design, which include only a single central raised portion associated with each pair of outer raised portions, the Bonko '631 tire has a pair of aligned central raised portions associated with each pair of outer raised portions. Thus, even assuming that Bonko '631 would have suggested to a tire designer of ordinary skill some modification of the central raised portions of Bonko '923, absent the appellant's own design, we are at a loss to know why the ordinary designer would have singled out only the alignment and not the number of central raised portions for incorporation into the Bonko '923 design as the examiner proposes. The incorporation in the Bonko '923 design of the

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number of central raised portions shown in the Bonko '631 design would, of course, yield a design which is strikingly different from the appellant's design.

Moreover, it is significant that the outer raised portions of the Bonko '631 tire are oriented relative to one another such that each pair presents an overall impression of a diagonal line. In contrast, the outer raised portions of the appellant's design and the Bonko '923 design are oriented relative to one another such that each pair presents an overall impression of a partial "V" configuration. Given the significant difference in the overall impressions presented by the Bonko '923 and Bonko '631 designs, it is not apparent to us, absent the appellant's own design, which orientation (direction of lean), if any, the Bonko '631 design would have suggested to the ordinary designer for the raised portions of the Bonko '923 design.

From our perspective, the only suggestion for putting the selected design features from the references together in the manner proposed by the examiner to arrive at the appellant's design is found in the luxury of hindsight accorded one who first viewed the appellant's design. We therefore conclude

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that the prior art references applied by the examiner are not sufficient to establish a prima facie case of obviousness of the claimed design.⁴ Accordingly, we cannot sustain the examiner's obviousness rejection.

We note, moreover, that, although appellant made no such argument in the brief, Bonko '923 does not appear to qualify as prior art under 35 U.S.C. § 102 with respect to the claimed design on appeal. The Bonko '923 patent was issued to Mark Leonard Bonko (appellant) on February 11, 1997 on design application number 29/052,099, filed March 22, 1996. Since the inventor of the Bonko '923 patent is the same as the inventor of the claimed design on appeal, the Bonko '923 patent is not available as prior art under 35 U.S.C. § 102(a) or (e). Further, since the Bonko '923 patent was not issued more than one year prior to the April 25, 1997 filing date of the instant design application, it is not available as prior art under 35 U.S.C. § 102(b).

⁴ As we have determined that the prior art is insufficient to establish a prima facie case of obviousness of the claimed design, it is not necessary for us to consider the declarations of Ross Fischer and Mark Carpenter filed by the appellant with the brief.

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CONCLUSION

To summarize, the decision of the examiner to reject the design claim under 35 U.S.C. § 103(a) is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
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JENNIFER D. BAHR)	
Administrative Patent Judge)	

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